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Wenderoth Lind & Ponack LLP				
2033 K Street NW Suite 800				
Washington, DC 20006				
		EXAMINER		
		SHIN, KYUNG H		
		ART UNIT		
		PAPER NUMBER		
		2132		

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,147

Applicant(s)

SHODA ET AL.

Examiner

Kyung H Shin

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responding to application papers dated 8/31/2000.
2. Claims 1-17 are pending. Claims 1, 16 and 17 are **independent**.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-17** are rejected under 35 U.S.C. 102(e) as being unpatentable over **Gregg et al.** (U.S. Patent No. 6,516,416: Subscription access system for use with an untrusted network, File date – June 11, 1997).

Regarding Claim 1, 16, 17, Gregg et al. discloses a data processing apparatus, a data processing method and a recording medium with a program recorded therein, said program for executing, on a computer, a data processing method executing a process on copyrighted data within a right obtained, comprising:

- a) data storage means operable to store the data; (see col. 4, lines 50-54: SQL database for the storage of the intellectual property, copyrighted, data. *"The clearinghouse consists of a structured query language (SQL) database which hosts the clearinghouse database ...which authenticates subscribers on behalf of the subscription access server ..."*)
- b) right information storage means operable to store a process right that is required for the process on the data stored in said data storage means; (see col. 20, lines 34-40: Obtain the process rights information for a copyrighted intellectual property from the database. *"The server application reads the copyright level of protection for the contents from the content headers.....The server applications then sends the copyrighted contents to the client application ..."*)
- c) input means operable to input an instruction for the data stored in said data storage means; (see col. 20, lines 53-58: Input the selection for a process right which is translated into a instructional message (a command function) forwarded to the server. *"However, if one of those options were chosen, the subclass client application recognizes the user's selection as a unique message ... and the subclass client application forwards the user message to the content controller".*)
- d) control means operable to determine, based on said process right stored in said right information storage means, whether said instruction is to be executed or not; (see col. 20, lines 1-7: Determine whether selected copyright protection instruction is to be executed or not. *"...The copyright protection instruction*

includes a command to implement the protection and an integer denotes the level of copyright protection that need to be implemented.”)

- e) process execution means operable to execute said instruction; (see col. 20, lines 20-27: After selection of copyright protection instruction, instruction is implemented (executed). *“The user must then choose which of the three options to implement. ... If the user chooses one of the three, the client application recognizes the user selection in the form of a unique message ... and which of those options is chosen is then determined (blocks 340, 342, 344) which results in activation of the particular function (block 346, 348, 350).”*)
- f) display means operable to display said process right stored in said right information storage means on a screen. (see col. 20, lines 18-20; Fig. 25-378: Available options are displayed in an informative screen on a display device. *“The client application displays the contents to the user with the options of print, save, cut/copy/paste enabled.”*)

Regarding Claim 2, Gregg et al. discloses the data processing apparatus according to claim 1, further comprising data receiving means operable to receive the data stored in said data storage means through a communication channel, and obtain said process right stored in said right information storage means through the communication channel. (see col. 20, lines 11-18: A user on a client system receives the copyright protected contents from the server system. *“A user requests the contents from a server application through a client or user application (block 330) which results in the server application sending the contents to the client application (block 332).”*

Regarding Claim 3, Gregg et al. discloses the data processing apparatus according to claim 1, wherein said process execution means includes data copy means operable to copy the data stored in said data storage means to a removable storage medium and delete the data copied to said storage medium based on a determination by said control means. (see col. 19, lines 61-66: If the copyright protected contents are designated as copy protected, then the contents cannot be copied using traditional means (PC copy data to hard drive, floppy drive, CD drive). If the user has the permission to copy the copyright protected contents, then the contents can be copied using traditional means (PC copy data to hard drive, floppy drive, CD drive). *"In accordance with still another important aspect of the present invention, the system is adapted to provide copyright or intellectual property protection ... if the content is designated as being protected, a user will be prevented from copying the content in any of the traditional ways."*)

Regarding Claim 4, Gregg et al. discloses the data processing apparatus according to claim 3, wherein said right information storage means stores storage medium information for identifying said storage medium, and said display means displays said storage medium information on a screen. (see col. 21, lines 19-20: A web browser window is setup using HTML (web based) procedures and displayed on a display screen. The display screen can display multiple types of information: Option Screens, Warning Screens, Error Screens, and Information Input Screens. *"The plug in subclasses the web browser window where HTML contents are displayed (block 438) and the user chooses on of the ... options."*)

Regarding Claim 5, Gregg et al. discloses the data processing apparatus according to claim 4, wherein when said input means selects the data copied to said storage medium, said display means displays the storage medium information of said storage medium on the screen. (see col. 21, lines 20-22: The display window is setup using established web browser icons and links to successive web pages or program executions (process right options) that are invoked using a pointing device (such as a mouse device). *"... HTML contents are displayed (block 438) and the user chooses one of the print, save or cut/copy/paste options (block 440)."*)

Regarding Claim 6, 7, Gregg et al. discloses the data processing apparatus according to claim 4, wherein said storage medium information is a storage medium identifier unique to said storage medium and assigned to said storage medium for identification. (see col. 31, lines 28-31: Subscription ID indicates a unique identifier for each subscription access, copyrighted process right. *"Unique ID assigned to each subscription defined for a company in the subscription access server system."*)

Regarding Claim 8, Gregg et al. discloses the data processing apparatus according to claim 3, wherein said control means outputs a warning signal when determining that said instruction for copying the data to said storage medium is not to be executed; and said display means displays a warning screen based on said warning signal. (see col. 21, lines 34-37: If the process right instruction cannot be implemented, then a indicative (instruction is not allowed) message is displayed. *"Finally, if the message was a cut/copy/paste message, the program determines if the level permits this to be done*

(block 464) which if it does permit it (block 466) or if not, displays a message indicating as much.”)

Regarding Claim 9, Gregg et al. discloses the data processing apparatus according to claim 8, wherein said display means makes on said warning screen a display for prompting a user to obtain a process right required for data copy. (see col. 5, lines 24-27; see col. 35, lines 15-21: Modifications and extensions can be implemented to enhance and improve the operation of defined functions. When a warning screen is displayed for a non-allowed instruction, the invention is enhanced to display a message and update the process right information. The web based visual interface that administers and maintains subscription profiles interacts with this automated update procedure. *“The server 34 also includes a site administration software program that provides a web based visual interface to administer the session manager and maintain subscription profiles.”*)

Regarding Claim 10, Gregg et al. discloses the data processing apparatus according to claim 3, wherein said control means outputs a warning signal when determining said instruction for deleting the data from said storage medium is not to be executed, and said display means displays a warning screen based on said warning signal. (see col. 21, lines 34-37; see Fig. 26-422: If the “cut” option (delete) cannot be completed due to process rights, an indicative message is displayed. *“... if the message was cut/copy/paste message, the program determines if the level permits this ... if not, displays a message indicating as much.”*)

Regarding Claim 11, Gregg et al. discloses the data processing apparatus according to claim 1, wherein said display means displays one or more icons corresponding to said process right stored in said right information storage means on the screen. (see col. 21, lines 19-22: The display window is setup using established web browser icons and links to successive web pages or program executions invoked using a pointing device (a mouse). “... the web browser window where HTML contents are displayed ... and the user chooses one of the ... options.”)

Regarding Claim 12, Gregg et al. discloses the data processing apparatus according to claim 11, wherein said display means displays on the screen as many icons as the number of executions specified by said process right stored in said right information storage means. (see col. 21, lines 19-22: The display window is setup using established web browser icons and links to successive web pages or program executions invoked using a pointing device (a mouse).

“... the web browser window where HTML contents are displayed ... and the user chooses one of the ... options.”)

Regarding Claim 13, Gregg et al. discloses the data processing apparatus according to claim 1, wherein said display means displays on the screen said process right to data that can be processed in a set process mode. (see col. 7, lines 10-20; see col. 7, lines 29-42; see col. 7, lines 24-27) A function to initiate or update subscription access (set process rights mode), copyright process rights, information. Administration of subscription access information is completed using a visual (information display type)

web based interface. *"The user authentication daemon 58 also processes the subscription access server's request for online subscription application and online subscription activation."*)

Regarding Claim 14, Gregg et al. discloses the data processing apparatus according to claim 1, wherein said display means displays on the screen said process right stored in said right information storage means by switching a display method based on a set display mode. (see col. 7, lines 29-42: A function to initiate or update subscription access (set display rights mode), copyright process rights, information. The process right information database is updated. *"The subscription access server 34 authorizes each web transaction that involves subscription access protected content and does so by communication with the subscribers and implements intellectual property protection"*)

Regarding Claim 15, Gregg et al. discloses the data processing apparatus according to claim 1, wherein said control means outputs a warning signal when determining that said instruction is not to be executed, and said display means displays a warning screen based on said warning signal. (see col. 21, lines 7-10: If a copyright process instruction (save, delete or cut, copy) is not allowed, an indicative message is displayed. *"If it does, then the cut/copy/paste function is invoked (block 420) and if not, results in the copyright notice prohibiting this action (block(422)."*)

Conclusion

Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. U.S. Patent No. 6,006,332 to Rabne et al. discloses Rights management system for digital media.
 - b. U.S. Patent No. 6,681,212 to Zeng discloses Internet-based automated system and a method for software copyright protection and sales.

Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H Shin whose telephone number is 703-305-0711. The examiner can normally be reached on 6:30 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner
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KHS
April 2, 2004


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